



Docket No.: 244228US2X

2812

OBLON
SPIVAK
McCLELLAND
MAIER
&
NEUSTADT
P.C.

ATTORNEYS AT LAW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/687,634

Applicants: Yoshitaka SASAKI, et al.

Filing Date: October 20, 2003

For: THIN FILM MAGNETIC HEAD AND
MANUFACTURING METHOD THEREOF

Group Art Unit: 3643

Examiner: A.M. VALENTI

RECEIVED

JUL 27 2004

LICENSING & BUSINESS

SIR:

Attached hereto for filing are the following papers:

Reply to Denial of Petition for Retroactive License under 35 U.S.C. §184

Statement under 37 C.F.R. §5.25(a)(3) in Support of Petition for

Retroactive License under 35 U.S.C. §184

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon

Richard L. Chinn, Ph.D.

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DOCKET NO: 244228US2X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

YOSHITAKA SASAKI, ET AL.

SERIAL NO: 10/687,634

FILED: OCTOBER 20, 2003

FOR: THIN FILM MAGNETIC HEAD
AND MANUFACTURING METHOD
THEREOF

: ATTN: LICENSING AND REVIEW

*RECEIVED
JUL 27 2004
LICENSED*STATEMENT UNDER 37 C.F.R. § 5.25(a)(3) IN SUPPORT OF PETITION FOR
RETROACTIVE LICENSE UNDER 35 U.S.C. § 184COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

I, Yoshihiro Abe, hereby certify that:

1. The above-identified application was not under a secrecy order at the time it was filed in Japan and it is not currently under a secrecy order.
2. I filed a corresponding application with the Japanese Patent Office on October 16, 2003 and learned that a first U.S. filing was required by U.S. law on February 10, 2004. I immediately sought advice from our U.S. representatives. Since then I have been diligently seeking a retroactive foreign filing license through our U.S. representatives.
3. I filed the application abroad through error and without deceptive intent. At the time I filed the application in Japan I did not know that U.S. law prohibited such filings. I discovered my error while looking through a file wrapper of an unrelated case and found a foreign filing license attached to the official filing receipt of the unrelated application. The foreign filing license attached to the official filing receipt of the unrelated application. The

form cited 35 U.S.C. § 184 and after I checked the code I realized I should have obtained a foreign filing license for the above-identified application.

4. I declare under penalty of perjury under the law of the United States of America that the foregoing is believed to be true and correct.



Yoshijiro Abe

July 16, 2004

Date

DOCKET NO: 244228US2X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

YOSHITAKA SASAKI, ET AL. : EXAMINER: A.M. VALENTI

SERIAL NO: 10/687,634 :

FILED: OCTOBER 20, 2003 : GROUP ART UNIT: 3643

FOR: THIN FILM MAGNETIC HEAD
AND MANUFACTURING METHOD
THEREOF

REPLY TO DENIAL OF PETITION FOR RETROACTIVE LICENSE
UNDER 35 U.S.C. § 184

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

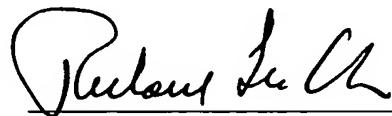
In regard to the above-identified application, Petitioners submit the attached Declaration. The Declaration is submitted to fully meet the requirements set forth in 37 C.F.R. § 5.25(a)(3). The Declaration is made by Yoshijiro Abe who is the person who had knowledge of the proscribed filing and made the decision to file abroad.

Petitioners now believe that all information required by 37 C.F.R. § 5.25(a) has now been submitted and Petitioners respectfully request that the Office grant the Petition.

Petitioners' U.S. representatives' address, facsimile number and telephone number are given below.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/687,634	20-Apr-04	YOSHITAKA SASAKI, ET AL.	244228US2X

Title: THIN MAGNETIC HEAD AND MANUFACTURING
METHOD THEREOF

Art Unit Paper Number

Correspondence Address:

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ALEXANDRIA VA 22314

PATENT & TRADEMARK OFFICE
MAILED

JUN 29 2004

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Norman F. Oblon
OBLON SPIVAK MCCLELLAND
MAIER & NEUSTADT
1940 Duke Street
Alexandria, VA 22314

In re: Yoshitaka Sasaki et al : DECISION ON REQUEST
Serial No.: 10/687,634 : UNDER 37 CFR 5.25
Filing date: 20 April 2004
Docket No: 244228US2X

Title: THIN MAGNETIC HEAD AND MANUFACTURING METHOD THEREOF

This is a decision on the petition filed on 20 April 2004 for a retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is **Denied** at this time in that the petition is defective since the declaration must be made by the person who was authorized to decide to file the foreign application. The declaration must include a statement along the lines that all statements made herein of his/her own knowledge are true and that all statements made on information and belief are believed to be true, and that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under section 1001 of Title 18 of the United States Code.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Andrea M. Valenti
Patent Examiner
Group 3643
(703) 305-3010

16 June 2004



Docket No.: 244228US2X

LS

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ATTORNEYS AT LAW

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Applicants: Yoshitaka SASAKI, et al.

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For: THIN FILM MAGNETIC HEAD AND
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Attached hereto for filing are the following papers:

Petition for Retroactive License under 35 U.S.C. §184

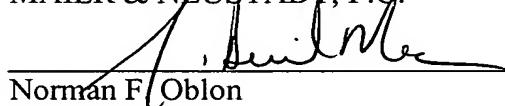
Certification of Translation

English Translation of Application Serial No. 10/687,634

Our check in the amount of \$130.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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